

REMARKS

The applicants have carefully considered the Office action dated August 1, 2007 and the references it cites. By way of this Response, claims 62 and 80 have been amended. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

The final Office action reiterated all of the previous rejections. In particular, the Office action again rejected all pending claims as being unpatentable over Houston, U.S. Patent 6,353,929, and one or more of Ozkan, U.S. Patent 6,031,577, Lotspiech et al., U.S. Patent 6,118,873, Gerace, U.S. Patent 5,848,396, Ciciora, U.S. Patent 5,815,297, Williams, U.S. Patent 6,259,443, Kaufman, U.S. Patent 5,003,591, and Saito, U.S. Patent 6,751,221. The applicants respectfully traverse these rejections.

Because all of the rejections are based on the Houston Patent, the applicants contacted John Houston, the named inventor of the Houston Patent, and asked him to evaluate the positions taken by the Examiner. Mr. Houston was available for contact because the Houston Patent has been assigned of record to Nielsen Media Research, the assignee of the instant application, and because John Houston is a paid consultant of Nielsen. The applicants sought Mr. Houston's candid view of the rejections based on the Houston Patent. Clearly, if the Examiner was correct in his entrenched positions, the applicants would have no interest in incurring the expense of continuing with these proceedings. However, as shown in the enclosed 132 Declaration, Mr. Houston himself does not agree with the Examiner's reading of the Houston Patent. Instead, Mr. Houston's declaration provides **strong evidence** that the Examiner's reading of the Houston Patent is in error, and that the positions

taken by the applicants for patentability are correct. Accordingly, the applicants are re-presenting these claims for examination and request that the Office give a fresh and fair reconsideration of the pending application. In this regard, the applicants wish to remind the Office that the Constitutional mandate of the USPTO, and the sole reason it exists, is to ***assist inventors in obtaining patent protection***. Thus, applicants request fair and complete consideration of the evidence. Such a fair minded examination will demonstrate that the claims of this application are in condition for allowance.

Response to Arguments

The final Office action is substantially a repeat of the prior Office action. While the final Office action ignores many of the points raised by the applicants in their prior response, Pages 2 and 3 of the Office action include four alleged responses to some of the arguments made in applicants' prior response. Applicants will now provide their reply to these responses.

First Response

At Page 2, the final Office action contends that the applicants have not provided evidence that the USPTO's prior position (i.e., that "Aras fails to teach or suggest recording the PID ... along with the time [of] reception, in that Aras teaches recording the payload data of the PID, and which has more information than the PID alone.") (Control No. 90/007,057, Notice of Intent to Issue Ex Parte Reexamination Certificate dated April 3, 2006, Statement of Reasons for Patentability and/or Confirmation, Pages 12-13) also applies to Houston. In response, the applicants have contacted John Houston and asked

him to evaluate whether his patent provided any motivation to collect PID headers. As shown in the attached declaration, Mr. Houston states:

5. With respect to independent claims 13, 61 and 79 of the '224 application as presented with the Response to the Office action of August 1, 2007 filed herewith, ***my patent makes absolutely no mention of collection and/or timestamping PID headers as a useful vehicle for performing media monitoring.*** While it is true that the methods and apparatus disclosed in my patent could certainly collect such PID headers (the methods and apparatus I disclosed can be used to collect virtually any type of media measurement data), my patent does not specifically disclose the concept of collecting and/or timestamping such PID headers or in anyway indicate that collecting and/or timestamping such PID headers would be of interest. ***Therefore, in my opinion, the only way a person of ordinary skill in the art at the relevant time frame reading my patent would be led to collect and timestamp PID headers, is if that person had a priori knowledge of the value of collecting such PID headers from another source.***

6. ***My patent described collecting payload data which may be associated with PID headers and, thus, in my opinion my patent does not by itself motivate someone to collect and timestamp PID headers.***

(Houston Declaration, Paragraphs 5-6)(emphasis added). Therefore, the applicants' prior argument (which substitutes the name Houston for Aras in the PTO's own prior argument) is correct. Specifically,

[Houston] teaches recording the payload data of the PID, and which has more information than the PID alone. Consequently, there is no motivation to store the PID information of [Houston] in that the [Houston] system already has similar information (derived from the payload portion but not the PID per se) stored.

Thus, applicants have provided ***compelling evidence*** that Houston and Aras have exactly the same shortcomings as prior art against the pending claims.

Namely, both of those references collect payload information and, thus, have no need for collecting PID headers to achieve their monitoring functions. Therefore, *for exactly the same reason the USPTO has previously concluded that there is no motivation to modify Aras to collect the PID headers themselves, there is similarly no motivation to modify Houston to collect such PID headers.* As a result, if the USPTO is to act in a logically consistent fashion, it is clear that the rejections of the claims reciting the recordation of PIDs (i.e., independent claims 13, 61, and 79 and all claims depending therefrom), based on Houston are in error and must be withdrawn.

Second Response

At Page 2 of the final Office action, the action contends that, while Houston refers to “unique id tags,” it “does not refer to using standardized program ids.” However, the Office action’s reading of the term “standardized program ids” is unduly narrow. Col 4, lines 40-44 of Houston describes *standardized identification tags* which are the same or equivalent to standardized *program identifiers*. Therefore, as argued in applicants’ prior response, there was no need to modify Houston to collect PID headers in order to have access to a “standardized program identifier.” Instead, standardized program identifiers were already present in Houston. Thus, the “first motivation” to modify Houston alleged in the Office action is fully contradicted by the Houston Patent itself.

Third Response

With the argument bridging Pages 2-3 of the final Office action, the action contends that “Houston is a tuning device.” However, Mr. Houston flatly contradicts this position. Mr. Houston states:

3. I have reviewed the final Office action’s argument that my patent is directed toward a tuning device. However, I respectfully submit that the Examiner misunderstands my disclosure when he describes it as a tuning device. My patent is directed toward an audience measurement system. It is not a tuning device and it does not seek to affect how audience members utilize their tuning devices nor does it seek to affect how such tuning devices operate to tune programs. Instead, specifically with respect to tuning devices, my patent relates to measuring how audience members utilize their own tuning devices. As such, there is no reason apparent to me to modify my patent to enable tuning of any sort, let alone to enable tuning “to sub-channels without acquiring the program map table (PMT)” as stated in the Office action.

(Houston Declaration, Paragraph 3). Since the second alleged motivation is based on the erroneous belief that the Houston Patent discloses a tuning device, it is clear that the second motivation for modifying Houston, like the first motivation, is fatally flawed. Since both alleged motivations for modifying Houston have been shown to be in error, all of the rejections based on modifying Houston to collect PID headers must be withdrawn. Accordingly, independent claims 13, 61, and 79 and all claims depending therefrom are in condition for allowance.

Fourth Response

With its final response on Page 3 of the final Office action, the Office action completely changes position from the first action. In the first action, the Examiner pointed to Col 8, lines 13-20 of Ozkan as teaching a reader connected to the IEEE 1394 protocol data port of digital television reception equipment to read program identifying data including identifier tags tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment as recited in independent claim 62. Since applicants demonstrated that no such reader can be found at the cited portion of Ozkan, the final Office action attempts to find such a reader in the external storage device 90 of FIG. 1 of Ozkan. However, this argument completely ignores the plain meaning of the term “reader” as used in the claims. Quite simply, a person of ordinary skill in the art would never construe a storage device as a reader connected to the data port of digital television reception equipment to read program identifying data tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment for use by a media device different from the digital television program reception equipment.

Moreover, the response of the final Office action completely misses the point of the applicants’ prior argument. As explained previously, the rejection is based on a hindsight effort to re-create the inventions of independent claims 62 and 80 of the application by combining Houston, Ozkan and Saito. However, this alleged combination requires a fundamental contortion of Houston that would only be considered if one already had the applicants’ invention firmly in mind (i.e., with hindsight reference to the applicants’ own disclosure). As explained by Mr. Houston himself:

4. The cooperative media handler methods disclosed in my patent provide access to a rich amount of audience measurement data, so there is nothing to be gained by employing eavesdropping methods such as those disclosed in the '224 application when my disclosed methods are available. Therefore, in my opinion, a person of ordinary skill in the art reading my patent in the relevant time frame would not be led by my disclosure to the invention recited in claims 62 and 80 of the '224 application as currently presented in the response to the Office action of August 1, 2007 filed herewith. *Quite simply, the techniques I disclose and the techniques recited in claims 62 and 80 relate to fundamentally different approaches to media measurement. Since my patent has no need of eavesdropping techniques such as those recited in claims 62 and 80, in my opinion, no person of ordinary skill in the art reading my patent would take it as suggesting the eavesdropping techniques of the '224 application.*

(Houston Declaration, Paragraph 4)(emphasis added).

The rejections all appear to ignore the fact that claims 62 and 80 *read program identifying data including identifier tags* tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the firewire data port. Instead, the rejections merely argue it would be obvious to use a firewire port with Houston to communicate data among multiple units. However, using the firewire protocol for upstream communication might result in exporting the data collected *within the monitored device* by the Houston cooperative media handler, but it provides *no rationale for completely changing the data collection mechanism of Houston* from a software agent internal to a monitored media presentation device to a reader that eavesdrops on communications to a second device to collect program identification tags output via the firewire port of a monitored media presentation device. In other

words, the motivation proposed by the Office action *might* lead one to forward the data collected internally by the Houston software agent upstream to the central data collection center, *but it would not lead one to replace the inventive Houston data collection mechanism with an external reader as recited in claim 62 or with the method of claim 80.*

In short, it is clear that none of Ozkan, Houston or Saito contemplate using a reader coupled to an IEEE 1394 data port to eavesdrop to collect program identification tags from data communicated to a second media device. At most the Office has identified a rationale for using IEEE 1394 communication protocols to transport data collected using the Houston cooperative media handler approach *internal* to the monitored device from the monitored device to an upstream device. This rationale, of course, is completely beside the point, as the applicants make no claim to being the inventor of IEEE 1394. The Office has failed to identify any teaching or suggestion for exploiting IEEE 1394 communication as a vehicle for collecting *program identifying tags* from data exported to a second media device. Indeed, given Houston's access to detailed audience measurement information *within* the monitored equipment via the cooperative media handler, there is no need for a reader coupled to an IEEE 1394 port of the monitored equipment to record identifier tags exported via the IEEE 1394 port of the monitored equipment. Therefore, the only reason anyone would read the Houston/Ozkan/Saito combination as teaching such an external reader is with a priori knowledge of the invention of claim 62 and/or 80. Of course, such hindsight usage of the teachings of the applicants' invention is not a proper basis for rejecting the applicants' claims. Accordingly, claims 62 and 80, as well as all claims depending therefrom, are in condition for allowance.

From the foregoing, it can be readily seen that, whereas the rejections made in the final Office action are inconsistent with both (a) the prior positions of the USPTO and (b) a fair and accurate reading of the prior art, the applicants have presented hard evidence of the patentability of the claims pending in this application. Accordingly, the evidence of record abundantly demonstrates that this case should be passed to allowance.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

Respectfully submitted,

HANLEY, FLIGHT & ZIMMERMAN, LLC.
Suite 2100
150 South Wacker Drive
Chicago, Illinois 60606
(312) 580-1020

By: /James A. Flight/
James A. Flight
Registration No. 37,622

December 3, 2007